



TRANSMITTAL FORM

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First Named Inventor

Petrus van Beek

Art Unit

2166

Examiner Name

Khanh B. Pham

Attorney Docket Number

7146.0100

ENCLOSURES (check all that apply)

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Incomplete Application☐ Reply to Missing Parts
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Date

October 26, 2007

Reg.
No.

54,405

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October 26, 2007

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant:	Van Beek, Petrus	Group Art Unit:	2166
Serial No.:	09/822,416	Examiner:	Pham, Khanh B.
Filed:	June 15, 2001	Customer No.:	55648
Title:	METADATA IN JPEG 2000 FILE FORMAT		

APPELLANT'S REPLY BRIEF

Chernoff, Vilhauer, McClung, and Stenzel, L.L.P.
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October 26, 2007

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P.O. Box 1450
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Dear Sir:

BACKGROUND

This REPLY BRIEF is in furtherance of the Notice of Appeal, filed in this case on March 5, 2007, the APPEAL BRIEF filed in this case on May 10, 2007, and the EXAMINER'S ANSWER mailed in this case on September 6, 2007.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN THE APPLICATION

There are 57 claims currently pending in the application.

B. STATUS OF ALL CLAIMS

Claims canceled: 32, 43

Claims withdrawn: None

Claims pending: 1-31, 33-42, and 44-59

Claims allowed: None

Claims objected to: None

Claims rejected: 1-31, 33-42, and 44-59

C. CLAIMS ON APPEAL

Claims 1-31, 33-42, and 44-59 are on appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection presented for review are (1) whether claims 1-31, 33-42, and 44-59 are unpatentable under 35 U.S.C. §101 as being directed to nonstatutory subject matter; (2) whether claims 47-49, and 54 are unpatentable under 35 U.S.C. § 102(a) as being anticipated by “JPEG 2000 Image Coding System” Final Committee Draft Version 1.0, March 16, 2000 (hereinafter JPEG 2000); and (3) whether claims 41, 42, and 44-46 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Pereira, “MPEG-7: a Standard for Describing Audiovisual Information,” 1999 (hereinafter Pereira) in view of “MPEG-7 Multimedia Description Scheme, Description Definition Language v3.0, N3391” (hereinafter referred to as MPEG-7).

ARGUMENT

1. Rejection of claims 1-31, 33-42, and 44-59 under 35 U.S.C. §101

The Examiner rejected claims 1-31, 33-42, and 44-59 as being directed to nonstatutory subject matter. The Examiner concedes that all claims are directed to a digital file stored on a computer-readable medium. *See* Examiner's Answer at p. 3. The Examiner also appears to concede that the claimed digital file defines a structure that facilitates the automated, visual reproduction of any *arbitrary* image stored in the digital file, i.e. the claimed data structure has a *functional* use. *See* Examiner's Answer at p. 9 (conceding that the claimed file structure, with the assistance of an image viewer, permits an *arbitrary* image, stored as claimed, to be displayed). The Examiner, however, maintains that the claims are directed to non-functional descriptive material, i.e. they are directed "a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music, a photograph or literary work, encoded on the medium." *See Id.* at p.10. As such, the Examiner contends that the claimed subject matter is copyrightable, not patentable. *Id.* at 9. The Examiner, for example, asserts that MS Word and Adobe Acrobat provide .doc and .pdf formats to store documents, hence any *document actually* stored in either of those formats does not become patentable simply because it is digitally stored. *See Id.* at p. 10.

The Examiner's argument is logically flawed, a point that is best shown by simply asking *what* photograph, literary work, document, etc. that is allegedly being claimed, or alternately, what material that the Examiner believes to be *merely described*, would be the subject of the Examiner's purported copyright. A cursory review of the rejected claims shows that no photograph, literary work, etc. is being claimed. The applicant is not claiming "the Mona Lisa stored in a JPEG 2000 format;" the applicant is claiming an *improved version of the JPEG 2000*

format itself. Although a person may use the claimed digital file to store the Mona Lisa (or other copyrightable descriptive material), the applicant's claimed subject matter more broadly relates to the functional structure of a digital file, i.e. what *type* of information is stored and *where*. This is the type of functional relationship between data elements that is properly the subject of a patent.

This latter distinction is easily seen in the numerous applications for software patents before the USPTO. So long as disclosed software is claimed in a manner integral to some media, the subject matter is patentable, even though the particular expression of that software, i.e. the code used to implement the claimed data structure of the software, is *also* copyrightable.

Independent claim 1 recites a data structure that functionally interacts with hardware to reproduce a visual image from stored digital data. Claim 1 differs from the prior art in that it more particularly specifies a structural or functional relationship between one sub-element of the data structure and the structure as a whole, i.e. a metadata box in the digital file stores information about whatever image content is selected by a user of the claimed file to be represented in the digital file. Thus, the descriptive aspect of claim 1 is *purely* functional as it relates to how and where data is stored, rather than describing any subjective aesthetic content that actually will be stored in the file by a user, which cannot be determined.

Furthermore, as applicant noted in the previously-filed Appeal Brief, claim 4 (as well as similar dependent claims such as claims 5-9, 18-23, 33-37, and 50-55) states particular functions to be enabled by the claimed digital file. Specifically, claim 4 recites that the information box "provides interactivity with said image." No reasonable argument can be made that this limitation is "merely descriptive" rather than "functional." If fact, such claims are

indistinguishable from those at issue in the *Wammerdam* decision, cited in applicant's Appeal brief, and notably ignored by the Examiner.

A recent case decided by the Federal Circuit on September 20, 2007 also illustrates this distinction. See *In re Petrus A.C.M. Nuijten*, ___ F.3d ___, 2007 WL 2728397 (Fed Cir. 2007). In that case, the applicant sought to patent method, apparatus, and signal claims to a watermark embedded within a digital image. Though the Federal Circuit, in a 2-1 decision, held that the signal claims were non-statutory as a signal is transient, they noted that the claims to a storage medium storing that data structure were patentable. The particular data structure claimed was to an improved watermark appended to a digital image that exhibited less image distortion than existing watermarks. A watermark actually encoded by the data structure claimed in the application of *In re Petrus* is itself nothing more than a description of the author, or an indication of a copyright, or other merely descriptive matter. etc. But the claims were not directed to the specific content displayed by the watermark, e.g. "COPYRIGHT 2007" but instead were more generically directed to the data structure that enabled the functional utility of providing a watermark with little image distortion, or more basically providing a watermark in the first instance. Thus, the functional matter of where data was encoded in the claimed data structure was patentable so long as it was claimed as stored on a tangible medium.

Both *Wammerdam* and *In re Petrus* seem to be dispositive of this issue. Furthermore, the only rejection of claims 1-31, 33-40, and 50-53, and 55-59 were on the basis that they were directed to non-statutory subject matter. Therefore, the applicant respectfully requests that the Examiner's rejection of these claims be reversed and they each be held patentable.

2. Rejection of claims 47-49, and 54 under 35 U.S.C. § 102(a) as being anticipated by JPEG 2000.

The Examiner's rebuttal with respect to claims 47-49 and 54 is premised on the incorrect assumption that the term "UUID Box" is merely descriptive and is not functional. Claim 47 begins by reciting that the claimed digital file is arranged in accordance of the JPEG 2000 specification, which not only defines a number of boxes, but specifies the type of information to be located therein, as well as its location in the data file so that it may be properly automatically interpreted by a computer. Thus, in a file "arranged in accordance with the JPEG 2000 specification", a UUID box and the content therein cannot be "mapped to" a UUID Info box, as claimed by the Examiner, because to do so *would render the information stored in the UUID info box unreadable*.

Stated differently, the claim limitation of "including information within said UUID box indicating the location of binary data, within said file and not within said UUID box, associated with said image" specifies, in a *non-arbitrary* manner, where in the file *relative to the remaining data*, the UUID box is located. Thus, in a JPEG 2000 file as claimed, a UUID box and a UUID Info box are functionally distinguished from each other by the position of the data respectively contained therein, within the file as a whole. More specifically, since the UUID info box of the JPEG 2000 specification must reference the location, i.e. identity, of the UUID box to which it applies, these boxes are not functionally interchangeable. Thus, the statement in the applicant's disclosure that the JPEG 2000 specification is sufficiently flexible so as to allows boxes to be omitted or rearranged is not, as the Examiner asserts, an implicit statement that any two arbitrary boxes can be interchanged or more specifically, that the data in a UUID Info Box may be interchanged with data in a UUID box.

Claims 47-49 are patentable over the prior art, and the Examiner's rejection of these claims should be overturned.

3. Rejection of claims 41, 42, and 44-46 under 35 U.S.C. § 103(a) as being obvious over Pereira in view of MPEG-7

The Examiner rejected claims 41-42 and 46 under 35 U.S.C. § 102(b) as being anticipated by Pereira. Independent claim 41 includes the limitations of an "MPEG-7 description scheme" where the MPEG-7 *description scheme* also includes "data for rendering said at least one of said audio and visual media when read by a computer." The Examiner's rejection is premised on the assumption that Pereira, by disclosing that reproduction data may be co-located on the same media or in the same data stream is tantamount to disclosing an MPEG 7 "description scheme" that includes such reproduction data. This is an illogical assumption. The fact that descriptive data, formatted in accordance with the MPEG 7 descriptive scheme, and image reproduction data formatted in accordance with the MPEG 2 or MPEG 4 description schemes, for example, may be present on the same disk, or transmitted sequentially in the same data *stream*, does not even imply, let alone disclose that the MPEG 7 *description scheme* includes image reproduction data. Again, the applicant reiterates the fact that, though Pereira discloses (1) ordering identification data in an MPEG-7 format; (2) ordering image reproduction data in an MPEG-2 or MPEG-4 format; and (3) co-locating MPEG-7 data with associated MPEG-2 or MPEG-4 in the same data stream does not disclose taking the reproduction data that would ordinarily be contained in an MPEG-2 or MPEG-4 format and including it within the MPEG-7 description scheme, *then* transmitting it in a data stream. Because the Examiner's rejection is based on an improper reading of the disclosure of Pereira, the applicant respectfully requests that the rejection of claims 41, 42 and 46 be reversed and the claims held patentable.

CONCLUSION

The Examiner's respective rejections of claims 20-27 and 30 should be reversed, and the claims should be found patentable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kurt Rohlf", followed by a long, horizontal, wavy line.

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